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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JON R. STIEBER, THOMAS P. ADAMS, ROBERT L. ZWIEG,
and WILLIAM R. KIRKMAN

Appeal 2008-3698
Application 10/005,023
Technology Center 2600

Decided: October 29, 2008

Before ROBERT E. NAPPI, SCOTT R. BOALICK,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

NAPPI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the rejection of claims 1 through 22.

We reverse the Examiner's rejections of these claims.

INVENTION

The invention is directed to a system for wirelessly monitoring cash handling equipment such as coin counters, bill counters, and coin dispensers. See pages 3 and 4 of Appellants' Specification. Claim 1 is representative of the invention and is reproduced below:

1. A wireless networked cash management system, comprising:
 - at least one cash handling device in the system for performing at least one of the operations of coin sorting, coin counting, note counting, note sorting and cash redemption;
 - a system control unit for performing at least one of a plurality of operations of accounting for cash dispensing by the cash handling device, providing for cash settlement of transactions carried out by the cash handling device and monitoring maintenance information, said control unit also providing commands to the cash handling device for operation of the cash handling device; and
 - wherein said cash handling device and said system control unit communicate through a wireless communication network operating according to a standard for locally distributed wireless networks; and
 - wherein the locally distributed wireless network communicates directly without intermediate servers and within a range between the cash handling device and the control unit of no more than approximately 100 meters.

REFERENCE

| | | |
|--------|-------------------|--------------------------------------|
| Waller | US 2001/0051922A1 | Dec. 13, 2001 (filed Feb 9, 2001) |
|--------|-------------------|--------------------------------------|

REJECTIONS AT ISSUE

Claim 20 stands rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. The Examiner's rejection is on page 3 of the Answer.

Claims 1 through 22 stand rejected under 35 U.S.C. § 102(e) as anticipated by Waller. The Examiner's rejection is on pages 4 through 7 of the Answer.

ANALYSIS

Rejection under 35 U.S.C. § 112, first paragraph

On pages 28 through 30 of the Brief, Appellants argue that the Examiner's rejection of claim 20 under 35 U.S.C. § 112, first paragraph is in error. Appellants assert the claim 20 limitation of "providing for cash settlement and monitoring maintenance information without needing authorization of user access from a remotely located network host computer" is supported by paragraph 0029 of Appellants' Specification. In response, the Examiner states on page 13 of the Answer:

The Examiner does not question whether the claim language is inconsistent with, or contradictory to, the teachings of the specification. But, the Examiner maintains that the specification does not clearly and concisely disclose to the skilled artisan that the inventors considered this particular authorization of user access claimed, *i.e., not* needing authorization of user access from a remotely located network host computer, to be part of their originally filed invention. There is therefore no force to the applicants' or affiant's arguments that the written description requirement was satisfied because the disclosure revealed a broad invention from which the later-filed claims carved out a patentable portion.

(Answer 13, emphasis in original).

We disagree with the Examiner's analysis. The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." *In*

re Wertheim, 541 F.2d 257, 262 (CCPA 1976). In order to meet the written description requirement, Appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *In re Gosteli*, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (emphasis in original). Finally, "[p]recisely how close the original description must come to comply with the description requirement of § 112 must be determined on a case-by-case basis." *Eiselstein v. Frank*, 52 F.3d 1035, 1039 (Fed. Cir. 1995) (quoting *Vas-Cath*, 935 F.2d at 1561).

The Examiner's statement that the claim is not inconsistent or contradictory to the Specification is an acknowledgement that the Specification demonstrates that Appellants possessed the invention at the time of filing the application. Further, the last sentence of paragraph 0029 makes clear that security and authentication features between devices *can* be used, thus implying that in the alternative they may not be used. In the context of Appellants' Specification, the host computer is remote from the user devices. Thus, we find that Appellants' Specification demonstrates possession of the claim limitation at the time of filing of the application. Accordingly, we find that the Examiner's rejection of claim 20 under 35 U.S.C. § 112, first paragraph is in error and we will not sustain this rejection.

Rejection under 35 U.S.C. § 102(e).

Appellants argue on page 8 of the Reply Brief that Waller is not prior art and therefore the rejection is improper. We agree. Appellants have claimed priority under 35 U.S.C. § 119(e) to a provisional application and the effective filing date for the instant application is December 4, 2000. The earliest date of Waller, which meets the requirements of 35 U.S.C. § 102(e), is the date Waller's application was filed in the United States: February 9, 2001. Thus, the effective filing date of Appellants' application predates the reference, and Waller is therefore not effective as prior art against Appellants' application. Accordingly, we will not sustain the Examiner's rejection of claims 1 through 22 under 35 U.S.C. § 102(e).

ORDER

For the aforementioned reasons we will not sustain the Examiner's rejection of claims 1 through 22 under 35 U.S.C. § 102(e) or the Examiner's rejection of claim 20 under 35 U.S.C. § 112.

The decision of the Examiner is reversed.

REVERSED

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